

Atty. Dkt. No. 074022-3302

Remarks

Support for the amendment of claims 1, 2, 5, 6, 18-19, and 23, is found, *inter alia*, at page 15, lines 18-21, page 5, line 23 – page 6, line 2; page 6, line 28 – page 7, line 8; and page 8, line 25 – page 9, line 4.

The Examiner rejects claims 1-2, 5-6, 9, 18-20, 22-24, 26, and 36 under 35 U.S.C. 103(a) as allegedly being unpatentable over Oberhardt (P/N 4,849,340). While the Applicant does not agree with the Examiner's finding for reasons stated previously, the presently amended claims are submitted without prejudice to further prosecution and solely in order to secure quick allowance of clearly allowable subject matter.

In order to establish a *prima facie* case of obviousness, it is necessary that the prior art reference teach or suggest all the claim limitations. MPEP 2142. It is also necessary that there be some suggestion or motivation to modify the reference.

Oberhardt does not disclose an optical assay device having channels that are continuous through each layer of the support. In the Office Action mailed 10/3/01, the Examiner alleged that Oberhardt contains an attachment layer with a binding agent layer (p. 5). But the structure indicated by the Examiner as containing an "attachment layer" does not contain channels that are continuous "through each of said layers of said support," i.e., that are continuous through the attachment layer, as presently claimed. Nor is any motivation present to provide an attachment layer with channels. Therefore, the presently claimed invention is not obvious over Oberhardt.

The Examiner rejects claims 1-17, 18-19, 21, 23, 25-26, 36, and 38-43 under 35 U.S.C. 103(a) as allegedly being unpatentable over Walt (P/N 6,023,540). The Applicant disagrees with this finding of the Examiner as well. However, in order to secure quick allowance of clearly allowable subject matter, the present amendment is submitted without prejudice to further prosecution. Among other elements, Walt does not describe channels that are continuous through each layer of the support.

Atty. Dkt. No. 074022-3302

The Examiner alleges that Walt discloses a device having layers and that each layer of the device has microscopic channels (Office Action mailed 12/16/03, p. 4, line 3) and that the layers are exposed to the sample solution indicating that liquid flow channels are present to permit such flow. The Applicant respectfully disagrees that this is a correct characterization of Walt. Nevertheless, Walt clearly does not disclose "channels continuous through each of said layers" (of the support) as the claims are presently amended.

The Examiner provisionally rejects claims 1, 2, 5-12, 23-24, 26-34, and 36-50 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 51-52, 54-55, 57-63, 66-68, 70-71, 73-79, and 82 of copending Application No. 09/675,518. The Applicant will submit a terminal disclaimer if the claims in the copending case are advanced to issue in their present form, and the claims in the present are otherwise allowable in their present form.

Atty. Dkt. No. 074022-3302

Conclusion

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-0872. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-0872. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-0872.

Respectfully submitted,

Date March 16, 2004

By Richard San Pietro

Richard J. Warburg
FOLEY & LARDNER
Customer Number: 23620

Richard San Pietro
Attorney for Applicant
Registration No. 45,071



23620

PATENT TRADEMARK OFFICE

Telephone: (858) 847-6700
Facsimile: (858) 792-6773